

Attorney Docket No. 170802-1010

REMARKS / ARGUMENTS

Claims 1-5 are pending, and all claims stand rejected based upon newly cited art. The present Office Action was made "final" even though the present Examiner has, at least tacitly, agreed that none of the art previously cited, nor any of the arguments previously made, rendered the present invention, as claimed heretofore, unpatentable.

Firstly, the Final Rejection states, "Claims 1-5 remain rejected over Reed as discussed in the previous office action mailed July 22, 2004."

Reference to the cited office action (mailed July 22, 2004) shows that in Section 5, thereof the Examiner held, "Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reed, Jr. (U.S. Patent No. 4,083,635)."

In holding Claims 1-5 to be unpatentable over the teachings contained in Reed, the Examiner took the position that Reed teaches a method for providing personal identification on checks issued by a payor to payees which includes the steps of:

obtaining an image of each payee by the payor, storing each said image on a storage medium by the payor, selecting payee data for check printing from each payee's data record, and printing checks for each said payee, each of said checks being printed with said payee data, said payee data including each payee's name and the amount of the check, and each said check being printed with an image of the payee, whereby each check will include, in addition to the other information, a photographic image of the payee to whom such check was written (Fig. 2, column 3, lines 11-47).

The Examiner acknowledged that Reed does not expressly show the use of a digital camera or scanner, or the step of storing each of the digital images on a computer medium

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by using a unique file name (such as a payee's social security number) associated with each payee. However, the Examiner took "Official Notice" that the use of a digital camera or a scanner, and the step of storing each of the digital images on a computer medium by using a unique file name (such as a social security number) associated with each person was considered old and well known. The Examiner stated that simply using a digital camera or a scanner, and storing each of the digital images on a computer medium by using a unique file name would give one just what one would expect from the process steps shown in Reed. In other words, it was the Examiner's position that "...there is no enhancement found in the claimed steps other than the known advantages of using a computer, such as efficiency and the increased speed in processing data and storing and retrieving data and images. The result is the same."

Accordingly, it was that Examiner's position that it would have been obvious to a person of ordinary skill in the art at the time of the invention to use a digital camera or a scanner, and to store each of the digital images on a computer medium by using a unique file name associated with each payee, because this would speed up the process of printing checks, which is purely known, and an expected result from automation of what is known in the art. Further, it was the Examiner's position that the specific steps taught by Applicant, "... greatly improves the efficiency of the system by providing an easier way of storing and retrieving data by using a computer, and a user-friendly system."

In responding to that office action, it was pointed out that the Examiner's reliance upon Reed was misplaced, as were the Examiner's arguments regarding patentability. In particular, 35 U.S.C. §103 *does not speak of "enhancements"*, it speaks of obviousness based on the teachings in the prior art. The very fact the Examiner acknowledged that Applicant's

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newly taught, inventive method provides enhancements over the teachings of the cited prior art, demonstrated that Applicant's invention is both novel (which was not questioned by the Examiner) and not obvious. After all, why would Reed not have taught an "enhanced" system, had he thought of it, and whether or not he thought of it, he certainly did not provide adequate teachings in his patent.

While in one aspect of his invention Reed teaches the use of "teller checks" in predetermined denominations. These are not produced in any manner remotely similar to the method taught by Applicant. Instead, Reed taught the use of *an office copy machine, blank checks, and an identification card* (See, Abstract and Col. 2, lines 21-39). Interestingly, Reed recognized the problems with a first negotiator trying to "... cash periodic payroll, social security, or welfare checks..." (See, Col 1, lines 20-23), yet Reed did not teach the invention of having the producer (payor) of those checks imprinting them with the photo of the payee, as in the present invention. Instead, Reed teaches placing an identification card on a window of a photocopy machine, and then feeding into the copier "check form sheets" in predetermined denominations (See, Col. 3, lines 21-59).

With respect to Fig. 1, and Col. 3, lines 11-31 of Reed, there is some discussion regarding the use of a computer having stored payee images which would be printed on checks, in a manner similar to that described by the present invention. However, Reed's teachings fail to address several items, including (1) how the images are created and stored (Applicant teaches the use of digital cameras and scanners); (2) what types of image files are used (Applicant teaches .jpg, .bmp, and .tif files); (3) how the files associated with the images relate to the checks as they are being printed (Applicant teaches the use of a unique file name which is associated with the

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image file using a database). In that the combination of the foregoing items are absent in the teachings of Reed, it cannot be reasonably argued by the Examiner that the present invention, as claimed, would have been obvious from the teachings of Reed.

In view of the foregoing, Applicant respectfully responds to the reference, in the Final Rejection, to the continued reference by the Examiner to the earlier rejection in the office action mailed July 22, 2004, by restating that that rejection was, and remains, improper, under the law.

Referring now to the new Final Rejection, the Examiner states, "Reed fails to teach the step of storing each such image in a suitable image format selected from the group consisting of 'jpg', 'bmp', and 'tif' formats, and that each file name being stored in a database which associates each file name with the digital image of each payee."

Having acknowledged the absence of such teachings in Reed, the Examiner turned, for the first time, to U.S. Patent No. 6,801,327 entitled **FILING SYSTEM AND METHOD, AND APPARATUS AND METHOD FOR REPRODUCING IMAGE DATA** which issued on October 5, 2004 to N. Haneda, et al. ("Haneda").

Applicant respectfully contends that the teachings of Haneda fail to disclose storage of image data in a database in a suitable image format with each file name being stored in a database which associates each file name with the digital image of each user.

Specifically, the Examiner pointed out various sections of the Haneda teachings, namely, the teachings contained at:

- (1) Column 14, lines 12-53;
- (2) Column 16, line 16 through column 17, line 42; and

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(3) Column 30, line 37 through column35, line 27;

Nothing in those cited portions, or elsewhere in Haneda, is related to the type of image storage required by the present invention, and defined in the existing claims. At the outset, while Haneda refers to the storage of photographs, neither the type of storage taught by Haneda, nor the reason for such storage, nor the manner of such storage are in any way related to the present invention. In particular, Haneda relates to a system for storing image data in albums, along with a system for printing photographic images by a processing laboratory. Nothing in Haneda discusses images of people, as opposed to, "... images of flowers, the images of animals and the images of a journey..." or an "...album of images having a common title..." (See, Abstract, FIG. 13, etc.). In particular, the entire intent of Haneda is to provide a filing system for storing, together, *i.e.*, in an "album" format, multiple images related to a common theme or subject. This is an entirely different issue than is presented by the present invention in which there is a single image, of a payee, relevant to a specific check which is to be printed. Accordingly, while it was Haneda's intent to provide a filing system in which a plurality of images related to some subject were separated from other, unrelated images, the present invention does not need or require any such filing system. In particular, in the present invention, all payees may have images in a single directory (or a single "folder", or "sub-folder", or "sub-directory"). All that matters (in the present invention) is that each image has a filename which is unique and which is associated with a particular payee. In Haneda, on the other hand, various "directories" (or "folders", "sub-folders", or "sub-directories") are used. Consequently, the path name to a given file is dependent (in Haneda) upon the specific album being referenced, which means that in Haneda, multiple image files can have the same (non-unique) filename so long as

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they are in different sub-directories. This is important to the invention described by Haneda in that it is intended to be used by multiple users in multiple locations, many of whom are likely to have used the same filenames to refer to images, particularly since such filenames are generally provided by the digital camera which was used to take the photograph, rather than by a human user. Thus, Haneda, specifically fails to teach a method for storing a digital image of a payee wherein each such image has a unique filename.

Further, unlike Haneda, the present invention is intended to be used to print checks, each containing a single image of the named payee. Haneda, on the other hand, is intended to print albums containing related images. Accordingly, it would be improper to relate the (admittedly deficient) teachings of Reed to the teachings of Haneda. Nevertheless, even if the respective teachings of Reed and Haneda could be related, they would still fail to teach Applicant's invention as defined by Claim 1.

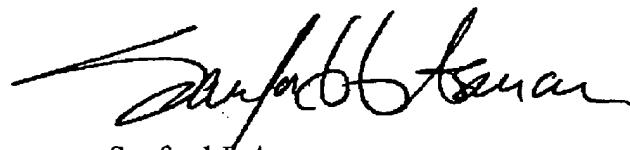
In that Claims 2-5 each add additional steps to the invention defined by Claim 1, each of those claims is also believed to be patentable over the cited art. Notably, Claim 4, includes the further step of using a payee's social security number, employee identification number, or the key field in the database containing the payee's data. Nothing in Reed or Haneda teaches the assignment of a unique filename to a digital image, wherein the unique filename is based upon the use of a payee's social security number, employee identification number, or the key field in the database containing the payee's data. Similarly, Claim 5 defines an invention in which the step of selecting payee data for check printing is accomplished by using data from each payee's data record to generate a filename which is uniquely associated with each payee's

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image file. Again, there is nothing in either Reed or Haneda, or any combination of them which would teach the invention defined by Claim 5.

Accordingly, in view of the comments herein, along with those previously made of record, Applicant respectfully contends that the claims, as previously presented, are allowable, and Applicant respectfully solicits their reconsideration and allowance at this time.

Respectfully submitted,



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